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| 09/521,177      | 03/08/2000  | Teruyuki Shitara     | 7217/61065          | 1416             |

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EXAMINER

ZIA, MOSSADEQ

|          |              |
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| ART UNIT | PAPER NUMBER |
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2134

DATE MAILED: 10/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/521,177

Applicant(s)

SHITARA ET AL.

Examiner

Mossadeq Zia

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-19 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

### *Claim Objections*

1. Claim 7 objected to because of the following informalities: In the Preliminary Amendment page 5, line 3, the sentence segment “stoning means” should read “storing means”.

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,4, 6,7, and 10-19 are rejected under 35 U.S.C. 102(b) as anticipated by Patent No. 5,787,171 Kubota et al.

3. Regarding independent claim 1, Kubota discloses a reproducing apparatus for moving main data that has been subjected to reproduction-restrictive coding from a first recording medium where the main data is recorded to a second recording medium, the apparatus comprising:

storing means for storing a key (terminal ID) used for decoding a code that restricts reproduction of the main data (Kubota , col. 8, line 42-44, col. 11, line 47-50),

input means (Kubota, fig. 1, label 5, 6) for receiving the main data from the first recording medium (Kubota, fig. 1, label 3, col. 4, line 16-19);

judging means (compares) for judging whether the main data received by the input means can be decoded by using the key that is stored in the storing means (Kubota, col. 12, line 2-8, and 10-11);

output means for outputting the main data received by the input means to the second recording medium (fig. 7, label 5); and

control (remote control) means for causing the output means to output the main data received by the input means to the second recording medium (Kubota, col. 7, line 48-51, col. 9, line 42-47) when the judging means judges that the main data can be decoded, and for prohibiting the output means from outputting the main data received by the input means to the second recording medium when judging means judges that the main data cannot be decoded (Kubota, col. 12, line 9-12).

4. Regarding claim 2, Kubota discloses the reproducing apparatus according to claim 1, further comprising key generating means for generating the key (security object generating circuit) for decoding the code that restricts reproduction of the main data, wherein the storing means stores the key generated by the key generating means (Kubota, col. 5, line 3-7, 15, col. 8, line 58-60).

5. Regarding claim 4, Kubota discloses the reproducing apparatus according to claim 1, wherein the key that is stored in the storing means is unique to the reproducing apparatus (Kubota, col. 4, line 40-42, col. 5, line 29-30, col. 11, line 42-43).

6. Regarding claim 6, Kubota discloses the reproducing apparatus according to claim 1, further comprising reproducing means for reproducing the main data that is

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input from the first recording medium, wherein the control means causes the reproducing means to reproduce the main data that is input from the first recording medium when the judging means judges that the main data can be decoded (Kubota, col. 5, line 28-33, 36-39).

7. Regarding claim 7, Kubota discloses the reproducing apparatus according to claim 1, wherein the storing means comprises first storing means and the key comprises a first key and further comprising:

second storing means for storing a second key (scramble key, col. 6, line 1-4) that is different from the first key used for decoding the main data (multimedia data, col. 4, line 37-39) input from the first recording medium (Kubota, col. 5, 27-28, col. 8, line 51-52); and

coding means (encoder) for coding the main data to be output from the output means to the second recording medium (Kubota, col. 4, line 26-29, 47-53), so that resulting coded main data is decoded by using the second key that is stored in the second storing means (Kubota, col. 8, line 46-47), wherein the control means decodes the main data by using the first key stored in the first storing means, causes the coding means to encode the main data in such a manner that the main data can be decoded by using the second key stored in the second storing means (Kubota, col. 7, 19-21, col. 8, line 46-47, 62-64), and causes the output means to output resulting coded main data to the second recording medium, when the judging means judges that the main data input from the first recording medium can be decoded (Kubota, col. 11, line 26-28, col. 12, line 1-8).

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8. Regarding independent claim 10, Kubota discloses an information distribution system comprising:

a server apparatus (service company) being connected to a terminal apparatus for supplying coded main data to the terminal apparatus (data receiver), the server apparatus including:

memory (data base) means for recording at least one coded main data; and  
(Kubota, fig. 1, label 1, col. 1, line 35-36)

transmitting means for transmitting to the terminal apparatus the coded main data that is read out from the memory means (Kubota, fig. 1, label 3, col. 4, line 16-19); and

the terminal apparatus for decoding and reproducing coded main data including:

receiving means for receiving the coded main data that is transmitted from the transmitting means of the server apparatus (Kubota, fig. 1, label 6; col. 4, line 21-23);

recording means (magneto-optical disk) for recording the coded main data (Kubota, fig. 1, label 6; col. 7, line 13-14, 35, 44-45);

decoding means for decoding the coded main data that is one of received by the receiving means and recorded in the recording means (Kubota, fig. 1, label 6; col. 7, line 38);

judging means for judging whether the terminal apparatus is connected to the server apparatus (Kubota, col. 11, line 35-38); and

control (remote control) means for controlling the decoding means to decode the coded main data received by the receiving means (Kubota, col. 7, line 48-51) when the judging means judges that the terminal apparatus is connected to the server

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apparatus (Kubota, col. 9, line 29-32), and for controlling the decoding means to decode the coded main data that is recorded in the recording means when the judging means judges that the terminal apparatus is not connected to the server apparatus (Kubota, col. 9, line 43-47).

9. Regarding claim 11, Kubota discloses the information distribution system according to claim 10, wherein the terminal apparatus (data receiving terminal) further comprises coding the means for coding main data, wherein the control means causes the coding means to encode the main data and causes the server apparatus to record the coded main data resulting therefrom. (Kubota, col. 11, line 26-28, col. 12, line 1-8).

10. Regarding claim 12, Kubota discloses the information distribution system according to claim 11, wherein the terminal apparatus further comprises attaching and detaching means for attaching the recording means to the terminal apparatus in a detachable manner (Kubota, col. 7, line 19-20).

11. Regarding claim 13, Kubota discloses the information distribution system according to claim 11, wherein the terminal apparatus further comprises: storing means for storing a key used when the coding means encodes the main data and used when the decoding means decodes the coded main data (col. 8, line 53-54), wherein the coding means encodes the main data by using the key stored in the storing means, and the decoding means decodes the coded main data by using the key stored in the storing means (Kubota, col. 8, line 34-36).

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12. Regarding claim 14, Kubota discloses the information distribution system according to claim 13, wherein the key that is stored in the storing means is unique (terminal ID) to the terminal apparatus (Kubota, col. 4, line 40-42, col. 5, line 29-30, col. 11, line 42-43).

13. Regarding claim 15, Kubota discloses the information distribution system according to claim 10, wherein the terminal apparatus further comprises reproducing means for reproducing decoded main data (Kubota, col. 7, line 35, 43-44).

14. Regarding claim 16, Kubota discloses the information distribution system according to claim 10, wherein: the terminal apparatus further comprises transmitting means for transmitting decoded main data produced by the decoding means (Kubota, col. 7, line 38-40, 44-46); and the server apparatus (service company) further comprises receiving means for receiving the decoded main data (Kubota, col. 4, line 3-5), and reproducing means for reproducing the decoded main data received by the receiving means, whereby the server apparatus reproduces the main data decoded by the terminal apparatus (Kubota, col. 10, line 64-66, col. 11, 1-11)

15. Regarding claim 17, Kubota discloses the information distribution system according to claim 16, the decoded main data that is transmitted from the transmitting means of the terminal apparatus is an audio signal (Kubota, col. 7, line 58-59).

16. Regarding claim 18, Kubota discloses the information distribution system according to claim 10, wherein the recording means of the terminal apparatus is a nonvolatile memory (Kubota, col. 7, line 14).



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17. Regarding claim 19, Kubota discloses the information distribution system according to claim 10, wherein the memory medium of the server apparatus is a hard disk drive (Kubota, col. 7, line 14).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over No. 5,787,171 Kubota et al as in view of No. 6,367,019 Ansell et al.

20. Regarding claim 3, Kubota discloses claim 2 above, but fails to disclose that the key generated by the key generating means and stored in the storing means is generated every time the main data that has been subjected to reproduction-restrictive coding is moved from the first recording medium and further comprising means for discarding the key every time movement of the main data is completed.

Ansell teaches key exchange conducted between portable player and external player (Ansell, col. 9, line 48-49) where random number is included to add variety to session encryption keys in a known and conventional manner (where it is known that a session key is disregarded after connections are terminated) to frustrate attempts to malicious and ill-tempered computer processes to masquerade as either players and having eavesdropped upon the dialogue between players (Ansell, col. 9, line 61-66).

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubota as per teaching of Ansell because the apparatus will gain the benefit of preventing unauthorized access to read-only keys (main data) (Ansell, col. 9, line 66-67).

21. Regarding claim 8, Kubota discloses the reproducing apparatus according to claim 1 above, but fails to disclose number-of-copying counting means for updating a count of the number of times of copying when the main data recorded in the second recording means is copied to the first recording medium and when the main data is moved from the first recording medium.

Ansell discloses a method where a Restriction state field stores data specifying the current state of the restriction on playback (number-of-copying) of data (Ansell, col. 11, line 39-40) acquired from a server (Ansell, col. 11 line 12-13). For example, if the restriction type, specifying a type of restriction on playback (Ansell, col. 11, line 19-20), is a number of time a SPT (copyrightable content) can be played back, restriction state field stores the number of times SPT has been played back to date (Ansell, col. 11, line 40-43).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubota as per teaching of Ansell because the apparatus will gain the benefit of a mechanism by which a copyrightable content of digital storage media is protected against unauthorized copying while offering the owner of such digital storage reasonable unimpeded convenience of use and enjoyment of the content (Ansell, col. 1 line 66-67, col. 2, line 1-3).

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22. Regarding claim 9, Kubota and Ansell discloses claim 8, and further discloses the reproducing apparatus according to claim 8, further comprising comparing means for comparing the count of the number-of-copying (playback) counting means with a permitted number of times of copying, wherein the control means prohibits copying when number of copies of the main data copied from the second storing means has reached the permitted number of times of copying as a result of comparison by the comparing means (Ansell, col. 11, line 49-55).

### ***Objections***

#### ***Allowable Subject Matter***

23. Claim 5 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Remarks***

24. No claims allowed.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Patent No. 5,768,389 generating and managing a secret key of  
public key cryptosystem, in which the secret key is stored  
in a tamper resistant device.

Patent No. 6,418,421 tracking usage of digital content.

Patent No. 5,787,179 scrambling method of a stream.

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Patent No. 6,061,451 data receiving apparatus - set top unit  
connected to network and a security module.

Patent No. 5,757,909 Illigal view and copy protection method in  
digital video.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Mossadeq Zia whose telephone number is (703)305-  
8425. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Greg Morse can be reached on (703)308-4789. The fax phone number for  
the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is 703-308-  
3900.

Mossadeq Zia  
Examiner  
Art Unit 2134

MZ  
10/03/2003

*Matthew B. Smithers*  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2134*